

Question Q217

National Group: Polish

Title: The patentability criterion of inventive step / non-obviousness

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?

Polish Industrial Property Law (further IPL) provides a definition of inventive step which is identical with the definition comprised in the European Patent Convention (further EPC). In compliance with art. 26(1) of IPL "an invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art" (vide art. 56 EPC.)

2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?

During the last 20 years there have been no fundamental changes in Poland pertaining to this standard. Aim for such changes introduced in August 2001 was the unification of nomenclature used in Polish national law and in EPC. In relation to the subject patentability criterion, the former Polish patent law used a term "unobvious" (understood as "not obviously resulting from prior art") which was replaced in IPL with the term „inventive step" being used in other European countries and in EPC.

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?

Polish Patent Office (further PPO) publishes a guide for inventors titled "Inventor's Guidelines" which discusses the current law and the proceedings before PPO. The

Guidelines also illustrates the PPO current practice. In the last edition as the methodology of “inventive step” appraisal, the problem-solution approach has been discussed. Taking into consideration the character of the publication and its addressees, more advanced readers (i. e. patent agents) may be dissatisfied with its contents. In comparison with EPO Guidelines, the Polish edition is far less detailed and does not contain any references to the PPO judicature.

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?

In accordance with the Polish law, the PPO is responsible both for the examination of patent applications and its granting and the examination of motions for patents invalidation and all the connected proceedings. The cause of the aforementioned is that the method for inventive step/ non-obviousness appraisal at the stage of right granting and its verification is uniform. Whereas the cases concerning patent infringement (i.e. infringement claims and non-infringement declaratory actions) fall within the civil courts jurisdiction. In such proceedings, the “inventive step”, if any was raised by the parties, used to be a marginal issue.

Construction of claims and interpretation of prior art

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?

In compliance with art. 63(2) of IPL “the scope of the protection sought shall be determined by the claims contained in the patent specification. The patent specification and drawings may be used to interpret the claims.” It had previously been accepted that the claims are read literally. In accordance with the current view, literal interpretation of claims is appropriate especially when formulation of them raise no doubts. In such case, there is no need to read the patent description to gain the right interpretation of the scope of protection (according to the so-called „*Clara non sunt interpretanda*” rule).

Currently in Poland there is a heated discussion pertaining to the possible broader interpretation of patent claims taking into account the equivalents, especially in case of the scope of protection interpretation resulting from the European Patents validation in Poland, where also the guidelines under art. 69EPC and its interpretative protocol which require the equivalents consideration should be taken into account.

6. Is it possible to read embodiments from the body of the specification into the claims?

In accordance with the above cited art. 63(2) of IPL, “Specification and drawings may be used for interpretation of claim.” In practice it shall raise no doubts that the embodiments from the body of the specification fall within the scope of protection resulting from the claims. However, there is no reason to identify the embodiments with the whole scope of the solution being defined by the claims.

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?

In compliance with the PPO practice, the prior art shall be interpreted as understood by a person skilled in the art. The so-called “inherent disclosures” will not be harmful for the novelty, but usually it will be considered by the PPO as sufficient for the lack of inventive step indication.

8. Do the answers to any of the questions above differ during examination versus during litigation?

Due to the double-track characteristic of the Polish patent system (vide 4), usually the risk of such differences does not exist. Only in case of interpretation of the scope of claims some differences may occur in accordance with lack of an unified practice concerning assessment of equivalents at the stage of enforcement.

Combination or modification of prior art

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference?

Yes, such possibility exists. A charge pertaining to lack of inventive step may occur particularly as an effect of such combinations: a) 2 embodiments of the same document of prior art, or b) 1 embodiment + common general knowledge (including well known technical equivalents).

If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)?

In both cases one shall refer to the common general knowledge of the person skilled in the art.

Is argument sufficient?

The argument will be especially effective when the documents illustrating the common general knowledge will be simultaneously presented (e.g. academic textbooks, professional guides, etc.)

Is the level of the common general knowledge an issue to be considered?

In such situation, it would be an issue which should be taken into consideration and supported by some additional evidence (vide the previous question)

10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?

In this scope, the PPO is not as precise as EPO. It is usually sufficient to indicate that both prior art references were actually available for the person skilled in the art and there were no contra to associate the documents. In practice, free combination of the documents of the same prior art shall not be questioned.

11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed?

Yes, it is relevant the technical fields to be close. It will be an additional argument for the opposition effectiveness.

How relevant is the problem the inventor of the claim in question was trying to solve?

It is highly relevant. PPO uses in this range an approach which is analogous with the EPO's problem-solution approach. The definition of an objective technical problem should include the invention presentation resulting from the description and confronted with the nearest state of art.

12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness?

Yes, in particular if it concerns partial problems with no synergistic effects.

Is the standard different from when only two references are combined?

There are no differences in such case.

13. Do the answers to any of the questions above differ during examination versus during litigation?

In light of the known practice of PPO and verdicts of the courts examining infringement cases, there are no significant differences in the range being discussed in this part.

Technical Problem

14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?

The description of technical problem is a starting point for determining inventive step and without this element the invention is not patentable. Only the solution for a particular technical problem disclosed in the application is capable of being recognized as an invention.

15. To what degree, if any, must the technical problem be disclosed or identified in the specification?

The technical problem should be disclosed in the description as a necessary element of the description of the claimed invention subject-matter. It is even more important because in some cases (e.g. use claims) the change of technical problem leads to the change of the invention subject-matter which affects the assessment of inventive step and interpretation of the scope of protection resulting from the patent. The technical problem identified by the applicant can be corrected, however, during proceedings through comparison of the disclosed solution with the state of art identified by the PPO.

Advantageous effects

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

Given that the advantageous effects are the direct technical effect of the use of the invention, or in other words the possibility of solving the technical problem delivered by the invention, then it should be accepted that like the technical problem, it too is an essential element in determining inventive step.

17. Must the advantageous effects be disclosed in the as-filed specification?

The description should disclose the technical effect of the use of the invention.

18. Is it possible to have later-submitted data considered by the Examiner?

Very rarely, and only in the case when it doesn't lead to any changes in the nature of the invention as disclosed in the application as filed. It is admissible to submit additional

evidence of the advantages stemming from the use of the invention, which, however, must fit within the confines of the general technical effect disclosed in the application as filed.

19. How “real” must the advantageous effects be? Are paper or hypothetical examples sufficient?

An advantageous effect not sufficiently proven cannot be taken into consideration (“Inventor’s Guide”). The submitted examples must thus be convincing enough in order to be considered sufficient. The demonstration that the examples contained in the description cannot be reproduced with the effects claimed by the applicant is sufficient to revoke the patent.

20. Do the answers to any of the questions above differ during examination versus during litigation?

In light of known PPO practice and verdicts by courts presiding infringement cases, there are no significant differences in the scope in question.

Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favour of inventive step / non-obviousness? Must the teaching be explicit?

The PPO recognises teaching away as a factor in favour of inventive step. This teaching shall be explicit.

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

If it is sufficiently demonstrated (i.e. it will unequivocally stems from the presented prior art documents) the teaching away is sufficient to demonstrate inventive step.

23. Is there any difference in how teaching away is applied during examination versus in litigation?

In light of known PPO practice and verdicts by courts presiding infringement cases, there are no significant differences in the scope in question.

Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?

The PPO may consider some secondary considerations as evidence for inventive step. However, proving one of these factors is sometimes not facile, especially when the provided arguments would be limited only to information concerning the commercial advantages of the invention.

25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the *claimed* invention and the secondary considerations required?

As secondary considerations which could be accepted by the PPO, one should mention: long felt but unresolved needs, the failure of others, scepticism by experts and teaching away by others. In each instance, the piece of evidence should constitute a reference to prior art

documents, and the solutions described therein should be closely connected with the claimed invention.

26. Do the answers to any of the questions above differ during examination versus during litigation?

In light of known PPO practice and verdicts by courts presiding infringement cases, there are no significant differences in the scope in question.

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?
If yes, please describe these issues, tests, or factors.

The above questions encompass all issues and factors that are taken into consideration in determining inventive step in Poland.

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and , if so, provide a brief summary of such interpretation.

Despite the fact that it doesn't stems directly from the IPL, in recent years, the PPO more and more willingly applies a methodology akin to the "problem solution approach" propagated by the EPO. The approach consists in:

- 1) identifying the closest prior art and determining the technical features of the claimed solution;
- 2) determining the objective technical problem, that is, determining, in the view of the closest prior art, the technical problem which the claimed invention addresses and successfully solves, and also indicating the significant technical features of the disclosed solution, i.e. those features that make it possible to solve the objective technical problem; and
- 3) examining whether or not the claimed solution to the objective technical problem is obvious for the skilled person in view of the state of the art in general, meaning whether the proposed significant technical characteristics remain non-obvious to the specialist.

29. Does such test differ during examination versus during litigation?

In practice, the test is performed by the PPO only during the examination of patent applications as well as possible revocation proceedings. It is identical in both cases.

Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

The area where there potentially may be discrepancies connected directly with the evaluation of inventive step is the interpretation of the scope of protection resulting from the patent performed by the court during infringement proceedings, and which refers to equivalents of

technical features of the claimed solution. Polish courts have not established a uniform practice in this case. From cases conducted in recent years, it can be surmised that it may be very problematic to perform an interpretation taking into account equivalents and there is no certainty whether the courts will be able to take into consideration that by accepting too broad an interpretation of the claims this may lead to a negation of the "inventive step".

31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

Only in the abovementioned scope.

Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?

In general, PPO and EPO practice at this time is the same in the evaluation of inventive step.

33. If yes, is this problematic?

N/A

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

34. Is harmonization of inventive step / non-obviousness desirable?

This harmonisation is desirable and necessary when, in a given territory, there may be valid patents granted by various offices (e.g. PPO vs. EPO). At the same time, any expectation that there may be a global and full harmonisation of the evaluation of inventive step seems to be unrealistic, since this does not take into consideration the fact that the differences between the local evaluation of this criterion usually stem from long-term practice established in a compared jurisdictions (i.e. EPO vs. USPTO).

35. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?

The rapid popularisation of the "problem solution approach" currently observable in Europe would suggest that it is possible to obtain a standard for inventive step / non-obviousness that would be universally acceptable and that the "problem solution approach" could be the basis for designing such a universal methodology. However, "problem solution approach" methodology too is not ideal. Its biggest drawback is its low resistance to attempts at changing the definition of the technical problem. In the end, the resulting evaluation of the inventive step of the product possessing particular technical features is primarily dependent on the accuracy of the formulation of the technical problem. This may lead to a certain pathological situation, where the main inventive activity consists of seeking new technical problems for known products, in order to prolong their patent protection.

36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.

possessing “inventive step” = not obvious to a person skilled in the art in light of prior art

37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.

This could be a methodology analogous to that described in point 28, where it would be worthwhile to supplement this in the future by stressing the real advantageous effects and taking into account secondary considerations, including information concerning the commercial advantages of the invention. This evaluation should be made based on the application as filed, and the definition of the objective technical problem should be defined in tight correlation with the contents of the application, without any possibility of amendments by the applicant at subsequent stages of the proceedings or during litigation.

Summary

Polish Industrial Property Law (further IPL) provides a definition of inventive step which is identical with the definition comprised in the European Patent Convention (further EPC). In compliance with art. 26(1) of IPL “an invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art” (vide art. 56 EPC).

In accordance with the Polish law, the PPO is responsible both for the examination of patent applications and its granting and the examination of motions for patents invalidation and all the connected proceedings. The cause of the aforementioned is that the method for inventive step/ non-obviousness appraisal at the stage of right granting and its verification is uniform. Whereas the cases concerning patent infringement (i.e. infringement claims and non-infringement declaratory actions) fall within the civil courts jurisdiction. In such proceedings, the “inventive step”, if any was raised by the parties, used to be a marginal issue.